

DOCKET NO: 242320US6

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
YOSHIKAZU KATO : EXAMINER: COPPOLA, J  
SERIAL NO: 10/656,274 :  
FILED: SEPTEMBER 8, 2003 : GROUP ART UNIT: 3621  
FOR: INFORMATION PROCESSING :  
APPARATUS, INFORMATION  
PROCESSING METHOD, STORAGE  
MEDIUM, AND PROGRAM

**APPEAL BRIEF WITH APPENDICES**

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal from a final Office Action mailed August 4, 2009. A Notice of Appeal was timely filed on October 5, 2009.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is SONY CORPORATION having an address at 1-7-1 KONAN, MINATO-KU, TOKYO, JAPAN, 108-0075. SONY CORPORATION is the real party in interest by way of assignment recorded in the U.S. Patent and Trademark Office at reel 014471, frame 0498.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and the assignees are aware of no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### III. STATUS OF THE CLAIMS

Claims 1-5 and 7-9 are pending. Claims 1-5 and 7-9 stand rejected, Claim 6 stands cancelled, and the rejection of Claims 1-5 and 7-9 is herein appealed.

### IV. STATUS OF THE AMENDMENTS

In an Office Action mailed August 4, 2009 (hereinafter "Outstanding Action"), the Examiner rejected Claims 1-5 and 7-9 after having been rejected at least one time previously. The attached Claims Appendix (section VIII) reflects Claims 1-5 and 7-9 as presently pending on appeal.

### V. SUMMARY OF THE CLAIMED SUBJECT MATTER<sup>1</sup>

The claimed invention, as recited in independent Claim 1, is directed to an information processing apparatus including an ordering means for receiving at least one order corresponding to a genre<sup>2</sup> and storing means for storing a plurality of content data corresponding to the at least one order.<sup>3</sup> Also included in the information processing apparatus are a managing means for managing preference data by which to determine

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<sup>1</sup> It is Appellant's understanding that, under the rules of Practice before the Board of Patent Appeals and Interference, 37 C.F.R. § 41.37(c) requires that a concise explanation of the subject matter recited in each independent claim be provided with reference to the specification by page and line numbers and to the drawings by reference characters. However, Appellant's compliance with such requirements anywhere in this document should in no way be interpreted as limiting the scope of the invention recited in all pending claims, but simply as non-limiting examples thereof.

<sup>2</sup> page 10, line 23 to page 11, line 1, Figure 4, element 101 and page 12, lines 2-6.

<sup>3</sup> Figure 4, items 58 and 112 and page 13, lines 6-9.

preferences based on a quantity of previous orders, each order corresponding to a genre<sup>4</sup> and reading means for reading said plurality of content data from said storing means in response to an instruction.<sup>5</sup> Finally, the information processing apparatus includes arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means<sup>6</sup> and composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display.<sup>7</sup>

The claimed invention, as recited in independent Claim 4, is directed to an information processing method implemented using an information processing apparatus having a central processing unit and a computer readable storage medium. The method includes the steps of receiving at least one order corresponding to a genre<sup>8</sup> and storing a plurality of content data in the computer readable storage medium, the plurality of content data corresponding to the at least one order.<sup>9</sup> In addition, the method includes managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre<sup>10</sup> and reading said plurality of content data, which is stored to said computer readable storage medium by said storing, in response to an instruction.<sup>11</sup> Further, the method includes arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing<sup>12</sup> and composing, using the information processing apparatus, said plurality of content data

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<sup>4</sup> page 10, line 23 to page 11, line 1, Figure 4, element 102 and page 13, lines 1-6.

<sup>5</sup> page 10, line 23 to page 11, line 1, Figure 4, element 103 and page 13, lines 6-11.

<sup>6</sup> page 10, line 23 to page 11, line 1, Figure 4, element 104 and page 13, lines 12-16.

<sup>7</sup> page 10, line 23 to page 11, line 1, Figure 4, element 105 and page 13, lines 17-22.

<sup>8</sup> Fig. 8, S41 and page 17, lines 3-15.

<sup>9</sup> Fig. 8, page 17, lines 15-19, page 13, lines 6-11.

<sup>10</sup> Fig. 8, S42 and page 17, line 20 to page 19, line 12.

<sup>11</sup> Fig. 8, S43 and page 19, line 13 to page 20, line 8.

<sup>12</sup> Fig. 8, S44 and page 20, line 8 to page 23, line 2.

arranged in said arranging, into a single document including the plurality of content data for display.<sup>13</sup>

The claimed invention, as recited in independent Claim 5, is directed to a computer readable storage medium encoded with computer program instruction which when executed cause a data processor to implement a method. The method includes the steps of receiving at least one order corresponding to a genre<sup>14</sup> and storing a plurality of content data, the plurality of content data corresponding to the at least one order.<sup>15</sup> Also included in the method are the steps of managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre<sup>16</sup> and reading said plurality of content data, which is stored by the storing, in response to an instruction.<sup>17</sup> Finally, the method includes the steps of arranging said plurality of content data read in said reading, in accordance with said preference data managed in said managing<sup>18</sup> and composing said plurality of content data arranged in said arranging, into a single document including the plurality of content data for display.<sup>19</sup>

The claimed invention, as recited in independent Claim 7, is directed to an information processing apparatus. Included in the information processing apparatus is an ordering unit configured to receive at least one order corresponding to a genre<sup>20</sup> and a storage unit configured to store a plurality of content data corresponding to the at least one order.<sup>21</sup> Also included in the information processing apparatus are a management unit implemented using a central processing unit and configured to manage a preference data by which to determine preferences based on a quantity of previous orders, each order

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<sup>13</sup> Fig. 8, S45 and page 23, lines 3-15.

<sup>14</sup> Fig. 8, S41 and page 17, lines 3-15.

<sup>15</sup> Fig. 8, page 17, lines 15-19, page 13, lines 6-11.

<sup>16</sup> Fig. 8, S42 and page 17, line 20 to page 19, line 12.

<sup>17</sup> Fig. 8, S43 and page 19, line 13 to page 20, line 8.

<sup>18</sup> Fig. 8, S44 and page 20, line 8 to page 23, line 2.

<sup>19</sup> Fig. 8, S45 and page 23, lines 3-15.

<sup>20</sup> Figure 4, element 101 and page 12, lines 2-6.

<sup>21</sup> Figure 4, items 58 and 112 and page 13, lines 6-9

corresponding to a genre<sup>22</sup> and a reading unit configured to read said plurality of content data stored by said storage unit in response to an instruction.<sup>23</sup> In addition, the information processing apparatus includes an arranging unit configured to arrange said plurality of content data, which is read by said reading unit, based on said preference data managed by said management unit<sup>24</sup> and a composing unit configured to compose said plurality of content data arranged by said arranging unit into a single document including the plurality of content data for display.<sup>25</sup>

## VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-3 and 7-9 are directed to non-statutory subject matter under 35 U.S.C. §101; whether Claims 1-3 are indefinite under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; whether Claims 1, 3-5, 7 and 9 are unpatentable under 35 U.S.C. § 103(a) based on Kent (U.S. Pat. Pub. No. 2002/0040374) in view of Nii (U.S. Pat. Pub. No. 2002/0065730); and whether Claims 2 and 8 are unpatentable under 35 U.S.C. § 103(a) based on Kent and Nii in further view of Applicant's Own Admission (herein "AOA").

## VII. ARGUMENT

### A. THE REJECTION OF CLAIMS 1-3 and 7-9 UNDER 35 U.S.C. § 101 AS DIRECTED TO NON-STATUTORY SUBJECT MATTER

The outstanding Action rejects both Claims 1 and 7 as being software per se, Applicants respectfully traverse this assertion. With respect to Claim 1, this claim recites means-plus-function features which must be considered in view of 35 U.S.C. §112, sixth paragraph. A proper analysis under 35 U.S.C. §112, sixth paragraph, requires consideration of the

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<sup>22</sup> Figure 4, element 102 and page 13, lines 1-6.

<sup>23</sup> Figure 4, element 103 and page 13, lines 6-11.

<sup>24</sup> Figure 4, element 104 and page 13, lines 12-16.

<sup>25</sup> Figure 4, element 105 and page 13, lines 17-22.

corresponding structure. 35 U.S.C. §112, sixth paragraph, states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.”

In the present case, as is noted above in section V, the structure of the means plus function elements of Claim 1 is clearly found in the disclosure as originally filed. Moreover, Applicants note that Figure 3 clearly illustrates the structure of the information processing apparatus recited in Claim 1. Moreover, page 10, line 23, to page 11, line 1 clearly states that the CPU 51 utilizes program code stored in RAM 53 to perform its processes. In other words, the CPU 51 is configured by the program code stored in the RAM 53 to perform certain processes. In support of this position, Applicants note *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999), where the Federal Circuit held that the time domain processing means is a microprocessor programmed to carry out the algorithm. In *WMS Gaming*, the Federal Circuit noted the statutory requirement to focus on corresponding structure.

The outstanding Action states that “Applicant’s original specification express states “[t]he series of steps described above may be executed by suitably functioning hardware or by software.” However, the outstanding Action has taken this phrase out of context. Specifically, the next line of the disclosure states “[f]or software-based processing to take place, programs constituting the processing sequences may be either loaded from dedicated hardware of a computer into its internal memory for execution, or installed upon program execution from a suitable program storage medium into a general-purpose personal computer or like equipment capable of executing diverse functions.” Thus, the specification clearly does not indicate that the invention can be performed using software only.

As is noted in MPEP §2106.01, “computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed

as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.”

With regard to Claim 7, Applicants note that this claim is directed to an information processing apparatus which includes at least a management unit implemented using a central processing unit. Applicants note that this claim cannot be asserted as being software *per se* as the claim expressly recites that the management unit is implemented using a CPU. The outstanding Action asserts on page 14, in item 45, that “while a “central processing unit” may be interpreted as hardware, the central processing unit is not positively recited in the claim. Accordingly, the claim is interpreted as software *per se*. If the “using a central processing unit” was considered positively recited and because the term “using,” the claim would be indefinite under 35 U.S.C. § 112 2<sup>nd</sup> paragraph because the claim would be a hybrid claim. See MPEP §2173.05(p) II.”

In response, Applicants note that the central processing unit recited in Claim 7 is clearly positively recited. Asserting that this feature is not positively recited is unsupported by the facts in question. Moreover, the assertion that the claim would be a hybrid claim also is completely unsupported. The phrase “a management unit implemented using a central processing unit” is not an attempt to claim a process without setting forth any steps as is discussed in MPEP §2173.05(p), such an assertion is not supportable by applicable law.

**B. THE REJECTION OF CLAIMS 1-3 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH AS INDEFINITE**

With regard to the rejection of Claims 1-3 under 35 U.S.C. §112, second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, Applicants respectfully traverse this rejection.

Specifically, the outstanding Action asserts on page 5, item 13 that the “written description fails to disclose the corresponding structure, material, or acts for the claimed invention.” However, although the outstanding Action mentions the written description, the rejection under 35 U.S.C. §112 is not a first paragraph rejection but instead a §112, second paragraph rejection.

MPEP §2173.02 states:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

There is no evidence that the outstanding Action has performed any analysis with regard to definiteness of the claim language in light of elements (A), (B) and (C) noted above.



Instead the outstanding Action appears to be making a written description rejection by stating that structure performing the recited functions cannot be found. Nevertheless, structure for the claimed means elements is clearly found in the disclosure as originally filed. As is noted above in section V, the elements of the invention are all clearly described in the disclosure as originally filed. Thus, Applicants respectfully submit that the rejection of Claims 1-3 under 35 U.S.C. §112, second paragraph is improper.

C. THE REJECTION OF CLAIMS 1, 3-5, 7 AND 9 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER KENT AND NII

Claim 1 relates to an information processing apparatus including an ordering means for receiving at least one order corresponding to a genre and storing means for storing a plurality of content data corresponding to the at least one order. Also included in the information processing apparatus is a managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre and reading means for reading said plurality of content data from said storing means in response to an instruction. Further, the information processing apparatus includes arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means and composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display.

Turning to the applied references, Kent describes a method of producing an individualized publication which gathers information from a plurality of sources and conglomerates the information into a single publication.

Nii describes a system for tailoring content to be delivered on a terminal-to-terminal basis. Further, Nii describes that the information to be delivered to a particular terminal is

determined based on a number of factors including previous items purchased by the potential customer.

However, the combination of Kent and Nii does not describe or suggest managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre and arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing, as is recited in Claim 1.

The outstanding Action acknowledges on page 7 in item 21 that Kent does not “disclose a means “by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre,” as recited in the claims.”

Nevertheless the outstanding Action cites the combination of Nii and Kent as disclosing this feature. Applicants respectfully traverse this assertion.

Specifically, Nii describes limiting the content provided to the terminal based on a number of factors including previous items purchased by the potential customer. Similarly, Kent describes limiting the content included in the publication based on preference data.

In contrast, the claimed invention does not remove content or limit the content which is displayed. Instead, the claimed invention **arranges** said plurality of content data, read in said reading, in accordance with said preference data managed in said managing.

Thus, the combination of Nii and Kent never discloses **arranging** said plurality of content data, read in said reading, in accordance with said preference data managed in said managing. The outstanding Action states on page 16, that Kent’s “profiling program 132” performs the claimed arranging said plurality of content data read by the reading means. However, Applicants note that the user’s profile 132 of Kent is not a program that arranges content. In contrast, the Kent reference does describe in paragraph 0070 that “an optimization

program 48 matches the content with the profile 132 and ensures that the database of content was efficiency correlated to match the user's requests and/or interests." However, instead of arranging the content data, the optimization program 48 of Kent limits the content included in the publication based on preference data. Nothing in Kent describes **arranging** said plurality of content data, read in said reading, in accordance with said preference data managed in said managing.

Similarly, Nii describes limiting the content provided to the terminal based on a number of factors including previous items purchased by the potential customer. However, Nii never describes **arranging** said plurality of content data, read in said reading, in accordance with said preference data managed in said managing.

Accordingly, the claimed invention has the advantageous feature of enabling a user to discover new content that may be interesting while at the same time providing content which the user has indicated as having a preference for in a conspicuous location on the page. This feature is not provided by the combination of Kent and Nii.

Thus, Applicants respectfully submit that Claim 1 and similarly Claims 4, 5 and 7, and claims depending respectively therefrom, patentably distinguish over Kent and Nii.

D. THE REJECTION OF CLAIMS 2 AND 8 UNDER 35 U.S.C. § 103(A) AS UNPATENTABLE OVER KENT AND NII IN FURTHER VIEW OF APPLICANT'S OWN ADMISSION (HEREIN "AOA")

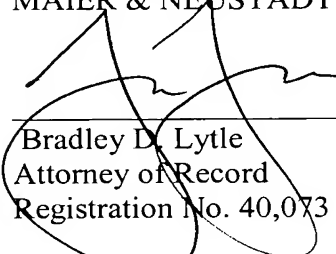
With regard to the rejection of Claims 2 and 8, Applicants initially note that these claims are allowable at least due to these claims' dependence from Claims 1 and 7, respectively. Moreover, Applicants note that the features disclosed in Claims 2 and 8 are not are not capable of instant and unquestionable demonstration as being well-known. As is noted in MPEP §2144.03, "it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697."

E. CONCLUSION

In view of the foregoing, it is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose or suggest the combined features set forth in Claims 1-5 and 7-9. Accordingly, it is respectfully requested that the rejections of Claims 1-5 and 7-9 be reversed.

Respectfully submitted,

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## VIII. CLAIMS APPENDIX

Claim 1 (Rejected): An information processing apparatus comprising:

ordering means for receiving at least one order corresponding to a genre;

storing means for storing a plurality of content data corresponding to the at least one order;

managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre;

reading means for reading said plurality of content data from said storing means in response to an instruction;

arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means; and

composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display.

Claim 2 (Rejected): An information processing apparatus according to claim 1, wherein said managing means determines said genre of said content data read by said reading means and associates the number of times that the plurality of content data belonging to said genre have been read with information for identifying a user for management purposes.

Claim 3 (Rejected): An information processing apparatus according to claim 1, wherein said plurality of content data include at least information for distinguishing said plurality of content data from other content data and information for indicating where said plurality of content data are stored in said storing means.

Claim 4 (Rejected): An information processing method implemented using an information processing apparatus having a central processing unit and a computer readable storage medium, comprising:

receiving at least one order corresponding to a genre;

storing a plurality of content data in the computer readable storage medium, the plurality of content data corresponding to the at least one order;

managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre;

reading said plurality of content data, which is stored to said computer readable storage medium by said storing, in response to an instruction;

arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing; and

composing, using the information processing apparatus, said plurality of content data arranged in said arranging, into a single document including the plurality of content data for display.

Claim 5 (Rejected): A computer readable storage medium encoded with computer program instruction which when executed cause a data processor to implement a method comprising:

receiving at least one order corresponding to a genre;

storing a plurality of content data, the plurality of content data corresponding to the at least one order;

managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre;

reading said plurality of content data, which is stored by the storing, in response to an instruction;

arranging said plurality of content data read in said reading, in accordance with said preference data managed in said managing; and

composing said plurality of content data arranged in said arranging, into a single document including the plurality of content data for display.

Claim 6 (Cancelled).

Claim 7 (Rejected): An information processing apparatus comprising:

an ordering unit configured to receive at least one order corresponding to a genre;

a storage unit configured to store a plurality of content data corresponding to the at least one order;

a management unit implemented using a central processing unit and configured to manage a preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre;

a reading unit configured to read said plurality of content data stored by said storage unit in response to an instruction;

a arranging unit configured to arrange said plurality of content data, which is read by said reading unit, based on said preference data managed by said management unit; and

a composing unit configured to compose said plurality of content data arranged by said arranging unit into a single document including the plurality of content data for display.

Claim 8 (Rejected): An information processing apparatus according to claim 7, wherein said management unit determines said genre of said content data read by said reading

unit and associates the number of times that the plurality of content data belonging to said genre have been read with information for identifying a user for management purposes.

Claim 9 (Rejected): An information processing apparatus according to claim 7, wherein said plurality of content data include at least information for distinguishing said plurality of content data from other content data and information for indicating where said plurality of content data are stored in said storage unit.



IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.